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Ex parte ROBERT T. UTHE

Appeal 2015-001676
Application 11/688,319[1]
Technology Center 3600

Before ANTON W. FETTING, NINA L. MEDLOCK, and
BRUCE T. WIEDER, *Administrative Patent Judges.*

WIEDER, *Administrative Patent Judge.*

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's rejection of claims 1–8, 10–21, and 23–26. We have jurisdiction
under 35 U.S.C. § 6(b).

We AFFIRM.

CLAIMED SUBJECT MATTER

Appellant's claimed "invention relates to processes that may involve
user or human interaction, and more particularly to a method and system to
automate a user out of a process flow." (Spec. ¶ 1.)

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[1] According to Appellant, the real party in interest is International Business
Machines (IBM) Corporation. (Appeal Br. 1.)

Claims 1, 12, 16, and 21 are the independent claims on appeal.

Claim 1 is illustrative. It recites:

1.   A method to automate a user out of a process flow, comprising:

determining, by a processor, if a process template associated with the process flow exists, wherein the process template comprises a user interface;

determining, by the processor, if a rule exists for automatic completion of at least a portion of the process template to automate the user at least partially out of the process flow in response to determining that the process template associated with the process flow exists, wherein determining if a rule exists comprises evaluating each rule in a list of rules based on a priority order of the rules in the list to find a rule with an associated criteria for automatic completion of at least the portion of the process template;

at least partially completing, by the processor, the process template automatically without user input in response to an existing rule for the process template, wherein the process template is automatically populated based on a content of the existing rule; and

presenting a graphical user interface for creating, editing and controlling activation of the list of rules, presenting the graphical user interface comprises:

presenting the list of rules in the priority order;

evaluating the list of rules sequentially in the priority order of the list of rules; and

providing a mechanism for selecting a particular rule and changing a priority order of the particular rule in the list of rules.

REJECTIONS

Claims 1–8, 10–21, and 23–26 are rejected under 35 U.S.C. § 101 as directed to non-statutory subject matter.

Claims 1–8, 10–21, and 24–26 are rejected under 35 U.S.C. § 103(a)
as unpatentable over Borg (US 2004/0205530 A1, pub. Oct. 14, 2004),
Kirkpatrick (US 7,296,297 B2, iss. Nov. 13, 2007), and Keohane
(US 2008/0126983 A1, pub. May 29, 2008).

Claim 23 is rejected under 35 U.S.C. § 103(a) as unpatentable over
Borg, Kirkpatrick, Keohane, and Bryant (US 2004/0201690 A1, pub.
Oct. 14, 2004).

ANALYSIS

The § 101 rejection

In the Answer, the Examiner enters a new ground of rejection under
§ 101 "because the claimed invention is directed to non-statutory subject
matter because the claims as a whole, considering all claim elements both
individually and in combination, do not amount to significantly more than an
abstract idea." (Answer 3.) The Examiner determines that "[t]he claims are
directed to the abstract idea of a method of organizing human activities. The
claims are specifically directed to creating a priority order of rules and using
a GUI to edit the list of rules." (*Id.*) The Examiner also determines that

> [t]he additional element(s) or combination of elements in the
> claim(s) other than the abstract idea per se amounts to no more
> than: (i) mere instructions to implement the idea on a computer,
> and (ii) recitation of generic computer structure that serves to
> perform generic computer functions that are well-understood,
> routine, and conventional activities previously known to the
> pertinent industry.

(*Id.*)

3

Appellant disagrees and argues "that the Office has failed to provide an adequate explanation as is required to meet its burden of establishing that the pending claims are directed to an abstract idea." (Reply Br. 3.)

In 2014, the Supreme Court decided *Alice Corp. Pty. Ltd. v. CLS Bank Int'l*, 134 S. Ct. 2347 (2014). *Alice* applies a two-part framework, earlier set out in *Mayo Collaborative Servs. v. Prometheus Labs., Inc.*, 132 S. Ct. 1289 (2012), "for distinguishing patents that claim laws of nature, natural phenomena, and abstract ideas from those that claim patent-eligible applications of those concepts." *Alice Corp.*, 134 S. Ct. at 2355.

Under the two-part framework, it must first be determined if "the claims at issue are directed to a patent-ineligible concept." *Id.* If the claims are determined to be directed to a patent-ineligible concept, then the second part of the framework is applied. "We have described step two of this analysis as a search for an 'inventive concept' – *i.e.*, an element or combination of elements that is 'sufficient to ensure that the patent in practice amounts to significantly more than a patent upon the [ineligible concept] itself.'" *Id.* (brackets in original).

With regard to the first part of the framework, we agree with the Examiner that the claims are directed to a method of organizing human activities and, in particular, to the abstract idea of creating a priority order of a list of rules and presenting a graphic user interface to edit the list. (*See* Answer 3, *see also* Claim 1.) "The 'abstract idea' step of the inquiry calls upon us to look at the 'focus of the claimed advance over the prior art' to determine if the claim's 'character as a whole' is directed to excluded subject matter." *Affinity Labs of Texas, LLC v. DIRECTV, LLC*, 838 F.3d 1253, 1257 (Fed. Cir. 2016). In this case, the Specification discloses that the

invention is directed to "processes that may involve user or human interaction, and more particularly to a method and system to automate a user out of a process flow." (Spec. ¶ 1.) And claim 1, as a representative claim, recites "determining . . . if a process template . . . exists," determining . . . if a rule exists for automatic completion . . . of the process template," "at least partially completing . . . the process template," and presenting a GUI "for creating, editing, and controlling activation of the list of rules." (Claim 1.) Courts have treated claims directed to similar subject matter as directed to an abstract idea. *See Apple, Inc. v. Ameranth, Inc.*, 842 F.3d 1229, 1237, 1240–41 (Fed. Cir. 2016) (providing a GUI interface to generate menus, i.e., "list[s] of options available to a user displayable on a computer," with certain functions); *see also Intellectual Ventures I LLC v. Capital One Bank (USA)*, 792 F.3d 1363, 1369–70 (Fed. Cir. 2015) (providing an interactive interface to the user). Additionally, "the claims are not directed to a specific improvement in the way computers operate. *Cf. Enfish [LLC v. Microsoft Corp.*, 822 F.3d 1327, 1335–36 (Fed. Cir. 2016)]." *Apple, Inc.*, 842 F.3d at 1241. Therefore, we are not persuaded that these claims are not directed to an abstract idea.

We now apply the second part of the framework to determine if "the elements of the claim . . . contain[] an 'inventive concept' sufficient to 'transform' the claimed abstract idea into a patent-eligible application." *Alice Corp.*, 134 S. Ct. at 2357 (citing *Mayo*, 132 S. Ct. at 1294, 1298).

Appellant argues that "the pending claims do not grant a monopoly over the alleged abstract idea of creating a priority order of rules and using a GUI to edit the list of rules." (Appeal Br. 5.) Instead, Appellant argues, "the pending claims recite a particular way to automate a user out of a

process with a required set of specific operations that are far beyond the general concept of creating a priority order of rules and using a GUI to edit the list of rules." (*Id.*)

Appellant does not, however, persuasively argue why the cited claim limitations (e.g., "determining, by the processor, if a rule exists," "completing, by the processor, the process template," "presenting a graphical user interface") contain an inventive concept that transforms the abstract idea into patent-eligible subject matter. The introduction of the processor into the steps does not change this analysis. The Specification discloses that the "computer program instructions may be provided to a processor of a general purpose computer." (Spec. ¶ 16.) But "the mere recitation of a generic computer cannot transform a patent-ineligible abstract idea into a patent-eligible invention." *Alice Corp.*, 134 S. Ct. at 2358.

With regard to Appellant's argument regarding monopolization/preemption, "preemption may signal patent ineligible subject matter, [but] the absence of complete preemption does not demonstrate patent eligibility." *Ariosa Diagnostics, Inc. v. Sequenom, Inc.*, 788 F.3d 1371, 1379 (Fed. Cir. 2015). Moreover, "[w]here a patent's claims are deemed only to disclose patent ineligible subject matter under the [*Alice/Mayo*] framework . . . , preemption concerns are fully addressed and made moot." *Id.* Therefore, we are not persuaded that the "inventive concepts" recited by Appellant are sufficient to transform the abstract idea into patent-eligible subject matter. Thus, we are not persuaded that the Examiner erred in rejecting claims 1–8, 10–21, and 23–26 under § 101.

The § 103 rejections

Claim 1 recites, in relevant part, "presenting a graphical user interface for creating, editing and controlling activation of the list of rules, presenting the graphical user interface comprises: presenting the list of rules in the priority order."

The Examiner finds that Keohane "does teach presenting a graphical user interface for creating, editing and controlling activation of the list of rules" and that paragraph 59 of Keohane discloses "presenting the list of rules in the priority order." (Final Action 6.) The Examiner also finds that "[w]e can see in [Figure 3 of Keohane] that applicable entries are rules themselves, and the ordering rules are ordering the applicable entry rules." (Answer 5.)

> Appellant disagrees and argues
>
> that paragraph [0059] of Keohane is simply describing output characteristic rules 320 for specifying control of the output characteristics of a list of ordered, applicable entries for an auto-complete box from an entry database 306 (paragraph [0057] of Keohane) and not presenting the list of rules themselves in priority order as incorrectly suggested on page 6 of the Office Action.

(Appeal Br. 8 (brackets in original).) Appellant further argues:

> The applicable entry rules 320 and ordering rules 322 are merely components of the auto-complete controller 300. The applicable entry rules 320 specify rules for selecting those entries that are applicable for an auto-complete box from among entry database 306 (paragraph [0056] of Keohane). Ordering rules 322 specify rules for ordering the list of applicable entries for an auto-complete box (paragraph [0058] of Keohane). Accordingly, Applicant respectfully submits that there is no teaching or

suggestion in Keohane that the ordering rules are ordering the priority order of the applicable entry rules.

(Reply Br. 7 (brackets in original).)

We are persuaded of reversible error. Keohane discloses that "a user may select rules for controlling which entries to include in a list of entries for an auto-complete box, the ordering of the entries within the auto-complete box, and any other preferences for specializing the output of the list of entries for an auto-complete box for the user." (Keohane ¶ 55.) In particular, Keohane discloses that "[a]pplicable entry rules **320** specify rules for selecting those entries that are applicable for an auto-complete box from among entry database **306**." (*Id.* ¶ 57.) Keohane also discloses that "[o]rdering rules **322** specify rules for ordering the list of applicable entries for an auto-complete box." (*Id.* ¶ 58.) And Keohane discloses that "[o]utput characteristic rules **320** specify rules for controlling the output characteristics of the list of ordered, applicable entries." (*Id.* ¶ 59.) In short, Keohane discloses presenting an ordered list of applicable entries for an auto-complete box. (*See id.* Fig. 3, ¶¶ 58–59.) But we do not agree that the "entries are rules themselves" (*see* Answer 5), and it is not clear where Keohane discloses "presenting the list of rules in the priority order," as recited in claim 1.

Therefore, we are persuaded that the Examiner erred in rejecting claim 1 under § 103(a). Because independent claims 12, 16, and 21 contain similar language, we are also persuaded that the Examiner erred in rejecting claims 12, 16, and 21, and dependent claims 2–8, 10, 11, 13–15, 17–20, and 23–36 under § 103(a).

DECISION

The Examiner's rejection of claims 1–8, 10–21, and 23–26 under 35 U.S.C. § 101 is affirmed.

The Examiner's rejections of claims 1–8, 10–21, and 23–26 under 35 U.S.C. § 103(a) are reversed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED